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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/808,421	03/13/2001	Anthony Angelo Agoni	ALAW.001A	3477
20995 7590 08/01/2007 KNOBBE MARTENS OLSON & BEAR LLP 2040 MAIN STREET FOURTEENTH FLOOR IRVINE, CA 92614			EXAMINER TOMASZEWSKI, MICHAEL	
			ART UNIT 3626	PAPER NUMBER
			NOTIFICATION DATE 08/01/2007	DELIVERY MODE ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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# Office Action Summary

Application No.

09/808,421

Applicant(s)

AGONI ET AL.

Examiner

Mike Tomaszewski

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 27 March 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-6, 74 and 75 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6, 74 and 75 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_.

**DETAILED ACTION**

***Notice To Applicant***

1. This communication is in response to the amendment filed on 3/27/07. Claims 7-73 and 76-78 have been cancelled. Claims 1-3, 74 and 75 have been amended. Claims 1-6 and 74-75 are pending.

***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-6 and 74 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Rizzo et al.* (6,470,338; hereinafter *Rizzo*) in view of *Shubov et al.* (US 2002/0038233 A1; hereinafter *Shubov*), *Johnson et al.* (5,964,839; hereinafter *Johnson*) and *Official Notice*.

(A) As per currently amended claim 74, *Rizzo* discloses a system for matching potential clients with professional services providers which meet their personalized criteria comprising (Abstract):

- (1) means for identifying via a webpage a service provider (Fig. 3; col. 2 lines 49-65, col. 9 lines 18-42, col. 10 lines 7-43);
- (2) means for receiving data entered by potential clients using data entry devices, said received data being indicative of criteria, and automatically comparing said received data to data stored in a storage medium to identify one or more suitable professional services providers based upon said criteria (Fig. 1B; col. 3 line 59 to col. 4 line 32, col. 6 lines 5-53, col. 9 lines 18-42, col. 10 lines 7-43); and
- (3) means for receiving a response from at least one responding identified service provider, wherein the response is in reply to the clients request (Fig. 1C, 7; col. 7 line 39 to col. 8 line 51), wherein the service provider has signed up with the system for a membership fee and the client is able to use the system to access information about the service provider (reads on "agreement to use a communication-enhancing system") (col. 3 line 59 to col. 4 line 21) (As per the limitation of "a computer-based" communication-enhancing system, *Rizzo* discloses requiring an attorney to enter a User ID and password to enter the system, wherein the user is then able to email the clients through the system (Fig. 1C, 7; col. 3 line 59 to col. 4 line 11, col. 7 line 39 to col. 8 line 26). It is noted that entering a user ID and password into a system and then using that system to send emails to the client is considered to be a form of "receiving an agreement from said service provider to user a computer-based communication-

enhancing system to provide services to the client.” Further, it is noted that submitting a user ID and password to email clients is an agreement because the only way for the attorney to email the client is to “agree” to use the system by submitting a user ID and password. Without the submission of this information, the user is unable to gain access to the computer-based system to provide services (i.e., email) to the client.).

*Rizzo* does not expressly disclose a means for receiving an agreement from at least one client to use said service provider to provide services and a means for monitoring by the computer-based service-enhancing system a frequency of communications between said service provider and said at least one client during the time that services are provided to said at least one client.

*Shubov* discloses a means for transmitting an acceptance of a bid to an attorney computer (§ 153; p. 13, col. 2 claims 15-18) and a means for tracking consumers and attorneys use of the matching system (§§ 167-168).

At the time the invention was made, it would have been obvious to one of ordinary skill in the art to include the features of *Shubov* within the system of *Rizzo* with the motivation of allowing service providers and consumers to easily communicate about the services (*Shubov*: § 6).

*Rizzo* and *Shubov* do not expressly disclose specifically monitoring the frequency of the communications between the provider and the client during the time the services are provided to the client.

*Johnson* discloses monitoring the frequency of service-related communications between the provider and the client during the time the services are provided to the client (i.e., monitoring the real-time interaction between a service and a user, wherein the data collected includes the type of service and the type and number of inquiries made (reads on "frequency of the communications")) (col. 2 line 43-col. 3 line 18, col. 3 lines 37-59, col. 4 lines 49-60, col. 15 lines 9-21).

At the time the invention was made, it would have been obvious to one of ordinary skill in the art to include the features of *Johnson* within the system taught collectively by *Rizzo* and *Shubov* with the motivation of monitoring communications between a service provider and a customer (*Johnson*: col. 1 lines 18-54).

Lastly, Examiner takes *Official Notice* of Applicant's limitation pertaining to "wherein the service provider is human." Examiner notes that it is well known and obvious that services (e.g., legal, medical, etc.) are provided/performed by humans. As such, Examiner respectfully submits that this amended limitation does not distinguish Applicant's claimed invention over the prior art. The motivation for including this

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modification within the system taught collectively by *Rizzo*, *Thompson*, and *Shubov* is to identifying service providers at the individual level, that is, a particular human.

(B) As per claims 1-2, *Rizzo* discloses a method for matching potential clients with professional service providers comprising:

- (1) generating email messages to send to a client identifying a service provider (col. 7 lines 20-38);
- (2) accessing by the client the email messages having information about potential service providers (col. 7 lines 20-38);
- (3) receiving a response from at least one responding identified service provider, wherein the response is in reply to the clients request (Fig. 1C, 7; col. 7 line 39-col. 8 line 51), wherein the service provider has signed up with the system for a membership fee and the client is able to use the system to access information about the service provider (reads on "agreement to use a first service-enhancing system") (col. 3 line 59 to col. 4 line 21); and
- (4) performing steps 1-3 by a second service provider, wherein the second service provider is not a registered member (reads on "using a second service-enhancing system having at least one feature absent from the first service-enhancing system (col. 7 lines 19-67).

The remaining features of claims 1 and 2 repeat the limitations of claim 74, and are thus rejected for the same reasons given for claim 74.

(C) As per claim 3, *Rizzo* discloses a system for matching potential clients with professional services providers which meet their personalized criteria comprising (Abstract):

- (1) identifying via a webpage a service provider (Fig. 3; col. 2 lines 49-65, col. 9 lines 18-42, col. 10 lines 7-43);
- (2) receiving data entered by potential clients using data entry devices, said received data being indicative of criteria, and automatically comparing said received data to data stored in a storage medium to identify one or more suitable professional services providers based upon said criteria (Fig. 1B; col. 3 line 59-col. 4 line 32, col. 6 lines 5-53, col. 9 lines 18-42, col. 10 lines 7-43); and
- (3) providing by the service provider, such as a law firm or attorney, information about themselves including jurisdictions in which they practice, areas of expertise, size of the law firm, and email address (col. 3 line 59-col. 4 line 11), wherein the service provider submits a response in reply to the clients request (Fig. 1C, 7; col. 7 line 39-col. 8 line 51), wherein the service provider has signed up with the system for a membership fee and



the client is able to use the system to access information about the service provider (reads on "agreement") (col. 3 line 59 to col. 4 line 21).

*Rizzo* does not expressly disclose a means for receiving an agreement from at least one client to use said service provider to provide services and a means for monitoring by the computer-based service-enhancing system a frequency of communications between said service provider and said at least one client during the time that services are provided to said at least one client.

*Shubov* discloses a means for transmitting an acceptance of a bid to an attorney computer (§ 153, p. 13, col. 2 claims 15-18) and a means for tracking consumers and attorneys use of the matching system (§ 167-168).

At the time the invention was made, it would have been obvious to one of ordinary skill in the art to include the features of *Shubov* within the system of *Rizzo* with the motivation of allowing service providers and consumers to easily communicate about the services (*Shubov*: par. 6).

*Rizzo* and *Shubov* do not expressly disclose specifically monitoring the frequency of the communications between the provider and the client during the time the services are provided to the client.

*Johnson* discloses monitoring the frequency of the communications between the provider and the client during the time the services are provided to the client (i.e., monitoring the real-time interaction between a service and a user, wherein the data collected includes the type of service and the type and number of inquiries made (reads on “frequency of the communications”)) (col. 2 line 43-col. 3 line 18, col. 3 lines 37-59, col. 4 lines 49-60, col. 15 lines 9-21).

At the time the invention was made, it would have been obvious to one of ordinary skill in the art to include the features of *Johnson* within the system taught collectively by *Rizzo* and *Shubov* with the motivation of monitoring communications between a service provider and a customer (*Johnson*: col. 1 lines 18-54).

*Rizzo*, *Shubov*, and *Johnson* do not expressly disclose means for receiving an agreement from said service provider to communicate with said at least one of said potential clients in accordance with a predetermined communication frequency while providing services. However, it is well known in the legal profession that a service provider, such as a lawyer, has a duty to communicate with a client. (See Model Rules of Professional Conduct, Rule 1.4). The lawyer must keep a client reasonably informed about the client’s matter and must promptly comply with reasonable requests for information. Thus, it is well known that lawyers and clients agree to a “predetermined communication frequency” (i.e., that a lawyer will communicate frequently with the client) when a lawyer agrees to work on a client’s matter. The motivation for including

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this modification within the system taught collectively by *Rizzo*, *Thompson*, and *Shubov* with the motivation of ensuring the client is informed about the client's matter.

The remaining features of claim 3 repeat the limitations of claim 74, and are thus rejected for the same reasons given for claim 74

(D) As per claims 4 and 6, the Examiner notes that *Rizzo* discloses providing by the service provider, such as a law firm or attorney, information about themselves including jurisdictions in which they practice, areas of expertise, size of the law firm, and email address (col. 3 line 59-col. 4 line 11), wherein the service provider submits a response in reply to the clients request (Fig. 1C, 7; col. 7 line 39-col. 8 line 51), wherein the service provider has signed up with the system for a membership fee and the client is able to use the system to access information about the service provider (reads on "agreement") (col. 3 line 59-col. 4 line 21).

*Rizzo* does not disclose the agreement being to use a computer-software based process to assure that said service provider adheres to certain standards of care or the agreement from said service provider being to not pass on to any client any cost of using said computer software-based process. However, the differences between *Rizzo* and the prior art are only found in the nonfunctional descriptive material and are not functionally involved in the step recited. The step of receiving an agreement would be performed the same regardless of the terms of the agreement. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of

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patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 1583-84, 32 USPQ2d 1031, 1035 (Fed. Cir. 1994). For further guidance, note MPEP § 2106, common situations involving nonfunctional descriptive material are: "a process that differs from the prior art only with respect to nonfunctional descriptive material that cannot alter how the process steps are to be performed to achieve the utility of the invention."

(E) As per claim 5, *Rizzo* discloses a service provider paying a membership fee (col. 3 line 65-col. 4 line 5).

(F) As per claim 75, *Rizzo* discloses a system for matching potential clients with professional services providers which meet their personalized criteria comprising (Abstract):

- (1) means for identifying via a webpage a service provider (Fig. 3, col. 2 lines 49-65, col. 9 lines 18-42, col. 10 lines 7-43);
- (2) means for receiving data entered by potential clients using data entry devices, said received data being indicative of criteria, and automatically comparing said received data to data stored in a storage medium to identify one or more suitable professional services providers based upon said criteria (Fig. 1B; col. 3 line 59-col. 4 line 32, col. 6 lines 5-53, col. 9 lines 18-42, col. 10 lines 7-43); and

- (3) means for providing by the service provider, such as a law firm or attorney, information about themselves including jurisdictions in which they practice, areas of expertise, size of the law firm, and email address (col. 3 line 59-col. 4 line 11).

*Rizzo* does not explicitly disclose providing by the service provider certain minimum experience requirements, said experience requirements being more specific, or higher than those generally accepted or legally required to practice in the industry of said service provider.

*Thompson* discloses a replacement worker providing information on their certifications, wherein some of the certifications are more than is needed to teach (Fig. 3; col. 3 lines 5-25, col. 8 lines 15-63).

At the time the invention was made, it would have been obvious to one of ordinary skill in the art to include the features of *Thompson* within the system of *Rizzo* with the motivation of ensuring that the position is filled by someone who is qualified to take on the role (*Rizzo*: col. 3 lines 5-25).

*Rizzo* and *Shubov* do not expressly disclose means for receiving an agreement from at least one of said potential client to use said service provider to provide services and means for receiving an agreement from said service provider to communicate with

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said at least one of said potential clients in accordance with a predetermined communication frequency while providing services.

Shubov discloses a means for transmitting an acceptance of a bid to an attorney computer (§ 153, p. 13, col. 2 claims 15-18) and a means for tracking consumers and attorneys use of the matching system (§ 167-168).

At the time the invention was made, it would have been obvious to one of ordinary skill in the art to include the features of *Shubov* within the system of *Rizzo* with the motivation of allowing service providers and consumers to easily communicate about the services (*Shubov*: § 6).

*Rizzo*, *Thompson*, and *Shubov* do not expressly disclose means for receiving an agreement from said service provider to communicate with said at least one of said potential clients in accordance with a predetermined communication frequency while providing services. However, it is well known in the legal profession that a service provider, such as a lawyer, has a duty to communicate with a client. (See Model Rules of Professional Conduct, Rule 1.4). The lawyer must keep a client reasonably informed about the client's matter and must promptly comply with reasonable requests for information. Thus, it is well known that lawyers and clients agree to a "predetermined communication frequency" (i.e., that a lawyer will communicate frequently with the client) when a lawyer agrees to work on a client's matter. The motivation for including

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this modification within the system taught collectively by *Rizzo*, *Thompson*, and *Shubov* is to ensure the client is informed about the client's matter.

### ***Response to Arguments***

4. Applicant's arguments filed 3/27/07 have been fully considered but they are not persuasive. Applicant's arguments will be addressed hereinbelow in the order in which they appear in the response filed 3/27/07.

(A) On page 5 of the 3/27/07 response, Applicant argues that nothing in *Rizzo* relates to the later timeframe that concerns the actual providing of services.

In response to applicant's argument, Examiner respectfully submits that a recitation of the intended use (e.g., temporal aspects pertaining use of the system during "later timeframes") of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

(B) On page 5 of the 3/27/07 response, Applicant argues that there is neither any disclosure in *Rizzo* of receiving any kind of agreement from a service provider to communicate with a client in accordance with a predetermined communication

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frequency nor is there any disclosure in *Rizzo* of monitoring frequency of service-related communications between a service provider and a client.

In response, Examiner respectfully submits that under a broad, yet reasonable interpretation, the aforementioned limitations are indeed taught by the combined teachings of the prior art references applied. See section 3. (C), *supra*.

(C) On page 6 of the 3/27/07 response, Applicant argues that *Shubov* neither discloses any kind of system or method that is used to provide services nor any kind of service-enhancing or communication enhancing system for providing services.

First, Examiner reiterates that a recitation of the intended use (e.g., temporal aspects pertaining use of the system during “later timeframes”) of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

Second, Examiner notes that *Shubov* teaches that after services are complete, the consumer can rate the service provider and the rating will be for the individual consumer, as well as other consumers (*Shubov*: abstract)—Examiner considers this to be a kind of service-enhancing or communication enhancing system for providing services.

(D) On page 7 of the 3/27/07 response, Applicant argues that there is no motivation to combine the references.



In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). See section 3, *supra*, for motivations to combine the applied references.

(E) Applicant's remaining arguments in the response filed 3/27/07 rely on or re-hash the issues addressed above and therefore, are moot in view of the responses given above and incorporated herein.

### **Conclusion**

5. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the

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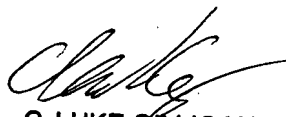
shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mike Tomaszewski whose telephone number is (571)272-8117. The examiner can normally be reached on M-F 7:00 am - 3:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached on (571)272-6776. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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